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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,318	12/31/2003	Scott R. Petersen	1001.1417102	1762

28075 7590 04/10/2007  
CROMPTON, SEAGER & TUFTE, LLC  
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MINNEAPOLIS, MN 55403-2420

EXAMINER
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HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/749,318

Applicant(s)

PETERSEN, SCOTT R.

Examiner

Mary Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-35, 38-50 and 53-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-35, 38-50 and 53-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/31/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species B, claims 33-35, 38-50, and 53-63 in the reply filed on 1/18/2007 is acknowledged. Non-elected, withdrawn claims appear to have been cancelled by applicant in the response filed 1/18/2007.

Election was made **without** traverse in the reply filed on 1/18/2007.

### ***Claim Objections***

Claims 38-44 and 53-59 are objected to because of the following informalities: Claims 38 and 53 depend from canceled claims. Claim 38 will be considered as being dependent from claim 33, and claim 53 will be considered as being dependent from claim 49.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33, 34, 35, 38, 41-50, 53, 56-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilson et al. (PG-PUB 2002/0052626).

Gilson discloses a method (see FIGS. 59-62) of loading a filter into a delivery sheath adapted for use in delivering the filter (40) within the vasculature of a patient, the delivery sheath (43) having a proximal end, a distal end, and a lumen extending through at least a portion of the distal end, the distal end of the delivery sheath having an exterior surface, comprising the steps of: providing a loading tool (7) having a proximal end, a distal end, and a lumen extending therethrough; providing a filter (40) generally longitudinally fixed on a guide wire (71) (i.e. the guide wire is fixed to the filter when being loaded into loading tool), the guide wire having proximal and distal portions, the filter connected to the distal portion; removing the filter, loading tool and delivery sheath from sterile packaging (paragraph 0201) (note Applicant does not claim that the filter AND the guide wire fixed thereto is removed from the sterile packaging); coupling the loading tool to the delivery sheath; inserting the proximal end of the guide wire into the lumen of the loading tool and pulling the guide wire (71) (see paragraph 0299], causing the filter to move toward the proximal end of the loading tool and shift from an expanded configuration within the lumen of the loading tool to a collapsed configuration (FIGS. 59-62); and pulling the filter within the lumen of the delivery device (paragraphs 0299-0302). The proximal end of the filter is in the expanded configuration within the lumen of the loading tool (FIG. 60) and thus the filter shifts from an expanded configuration within the lumen of the loading tool to a collapsed configuration (FIG. 61). The loading tool (7) fits over the exterior of the delivery sheath (43). The inside diameter of the

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loading tool (7) is greater than the inside diameter of the loading tool (7) at a second region. The loading tool comprises a notched region with a third diameter (see V-shaped bent region of ref. #7). The delivery sheath further comprises an outside and inside diameter, the inside diameter at the third inside diameter region of the loading tool being substantially equal to the outside diameter region of the delivery sheath, and the inside diameter region of the loading tool at the second inside diameter region and the inside diameter region of the delivery sheath being substantially equal. The loading tool is uncoupled from the delivery sheath.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 40, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilson et al. (PG-PUB 2002/0052626).

Gilson, as modified, discloses the claimed invention except for the size of the inside diameter of the first and second outside diameter regions. It would have been obvious matter of design choice to change the size of the diameters, since such a modification would have involved a mere change in the size of a component. The sizes that are claimed appear to be within the range of known filter delivery devices. A

change in size is generally recognized as being within the level of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments filed 09/19/2006 have been fully considered but they are not persuasive.

Applicant's argument that the guide wire is not "longitudinally fixed" to the filter is not persuasive. The guide wire of Gilson et al. extends through the filter, and pulling on the guide wire causes movement of the filter (e.g. see paragraphs [0046], [0299-0301] ref. #71). Since the filter is disposed longitudinally along the guide wire, it can be considered "longitudinally fixed" regardless of the fact that the guide wire and the filter have the capability relative each other. When the filter is not moving relative the guide wire, it can be considered "longitudinally fixed". It is noted the Applicant is not claiming non-removably fixed or that the filter is formed on or integral with the guide wire. Furthermore, Applicant's claims do not impose a specific order on the performance of the method steps, i.e. the guide wire of the prior art is fixed longitudinally to the filter in a different temporal sequence than described in Applicant's specification. However, since the language of the method claims do not impose a specific order on the performance of the method steps, and the specification does not directly or implicitly require a particular order, it has been held that it is improper to read a specific order of steps into method claims where, as a matter of logic or grammar even when the specification describes only a single embodiment. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65

USPQ2d 1865, 1869-70 (Fed. Cir. 2003). Of particular note, Applicant recites the step of "removing the filter, loading tool and delivery sheath from sterile packaging;" and makes no mention that the guide wire, with the filter being longitudinally fixed to the guide wire, is simultaneously removed from the sterile packaging along with the other components. Furthermore, unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one in cases when the method steps do not implicitly require that they be performed in the order written. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 59 USPQ2d 1401 (Fed. Cir. 2000) *Id.* at 1342-43, 59 USPQ2d at 1416. The examiner is interpreting the claims in view of the specification without unnecessarily importing limitations from the specification into the claims; therefore, since the claims do not require a particular temporal sequence, the *Gilson et al.* reference anticipates the currently recited claims.

It is further noted that the *Gilson et al.* reference, which shows a guide wire removably fixed to the filter, describes several advantages over the prior art, in which guide wires are non-removably fixed to filters (paragraphs [0146-0147], [0319]). Therefore, even if Applicant amends the claims to overcome the 102(e) rejection by specifying when and/or how the guide wire is longitudinally fixed to the filter, Applicant is notified that the claims may be subject to a 103(a) obviousness-type rejection.

The rejection is deemed proper.

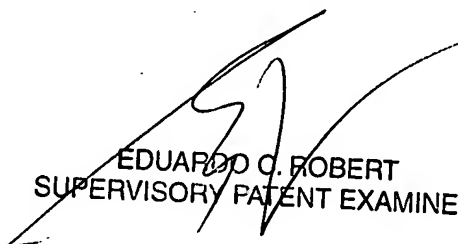
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER